

PATENT COOPERATION TREATY

REC'D 19 OCT 2004

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From the
INTERNATIONAL SEARCHING AUTHORITY

PCT

To:

see form PCT/ISA/220

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY (PCT Rule 43bis.1)

Date of mailing
(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference
see form PCT/ISA/220

FOR FURTHER ACTION
See paragraph 2 below

International application No.
PCT/EP2004/051248

International filing date (day/month/year)
25.06.2004

Priority date (day/month/year)
27.06.2003

International Patent Classification (IPC) or both national classification and IPC
C10G45/58, C10G65/12

Applicant
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1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☒ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☒ Box No. VIII Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA"). However, this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of three months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

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**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/EP2004/051248

Box No. I Basis of the opinion

1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
 - ☐ This opinion has been established on the basis of a translation from the original language into the following language , which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material:
 - ☐ a sequence listing
 - ☐ table(s) related to the sequence listing
 - b. format of material:
 - ☐ in written format
 - ☐ in computer readable form
 - c. time of filing/furnishing:
 - ☐ contained in the international application as filed.
 - ☐ filed together with the international application in computer readable form.
 - ☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/EP2004/051248

Box No. II Priority

1. ☒ The following document has not been furnished:

☒ copy of the earlier application whose priority has been claimed (Rule 43*bis*.1 and 66.7(a)).

☐ translation of the earlier application whose priority has been claimed (Rule 43*bis*.1 and 66.7(b)).

Consequently it has not been possible to consider the validity of the priority claim. This opinion has nevertheless been established on the assumption that the relevant date is the claimed priority date.

2. ☐ This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43*bis*.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.

3. Additional observations, if necessary:

Box No. V Reasoned statement under Rule 43*bis*.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	8,9,12-16
	No: Claims	1-7,10,11
Inventive step (IS)	Yes: Claims	
	No: Claims	1-16
Industrial applicability (IA)	Yes: Claims	1-16
	No: Claims	

2. Citations and explanations

see separate sheet

Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

see separate sheet

Re Item V

**Reasoned statement with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement**

Reference is made to the following documents:

D1: US 6 294 077
D2: WO 02/46333
D3: NL 1015035
D4: US 6 025 305
D5: US 2002/0146358

1. Lack of Novelty

1.1

The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of independent **Claim 1** is not new in the sense of Article 33(2) PCT.

Document D1 discloses a process to prepare a base oil by subjecting a mixture of a Fischer-Tropsch derived feed and a petroleum derived feed to a catalytic pour point reducing step (see D1: claims 1 and 2; column 7, lines 53 - 64).

The Examining Division admits that the paraffin content of the base oil is not mentioned in document D1. However, the technical process features disclosed in D1 do not differ from the technical process features of the present application. D1 discloses that the feedstock is dewaxed by selective conversion of waxy species while minimizing conversion of more branched species (see D1: column 7, lines 53-64). The Examining Division submits that some of the base oils have a paraffin content falling within the ambit of the presently claimed paraffin content.

Thus the subject-matter of independent Claim 1 is not new.

Similar novelty objections can be made based on documents D2 (claims 1 and 8; page 6, lines 1-11; page 10, line 24 - page 13, line 27), D3 (claims 1 and 26; page 20, line 1 - page 21, line 24), D4 (claims 1 and 4; column 3, line 1 - column 4, line 65) and D5 (claims 1, 5 and 11; par. 20; par. 21; par. 22; par. 50 and par. 85).

1.2

The following dependent Claims are also not new:

- **Claim 2:** see D3: claim 26; see D1: Examples 3 and 4; see D5: claim 2;
- **Claim 3:** see D2: page 7, lines 20-24; page 22, Table; see D3: page 30, Table; see D1: Table 3; see D5: par. 87;
- **Claim 4:** see D1: Table 6;
- **Claim 5:** see D2: claim 12; see D1: claim 3;
- **Claim 6:** see D1: Table 6;
- **Claim 7:** see D1: column 5, lines 8-17;
- **Claim 10:** see D2: page 17, lines 3-6; see D3: page 18, lines 16-26; see D4: column 5, lines 10-18;
- **Claim 11:** see D2: page 11, lines 18-32; see D3: claims 16 and 17; see D1: column 7, line 65 - column 9, line 39; see D5: page 8, par. 96 and 97;

2. Lack of Inventive Step

Dependent **Claims 8, 9, 12, 13, 14, 15 and 16** do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of inventive step.

Re Item VIII

The present application does not meet the requirements of Art. 6 PCT, because Claims 1, 2, 6, 8, 14 and 15 are not clear for the following reasons:

1. **Claim 1** attempts to define the subject-matter in terms of the result to be achieved (*a base oil having a paraffin content of between 75 and 95 wt.%*). However, the technical features to obtain this result should be clearly stated. Should this property be an inherent property of the obtained product, then this part of Claim 1 is superfluous. However, if further technical features are necessary in order to achieve this property, this have to be included in Claim 1.
2. **Claims 2, 8, 14 and 15** are process Claims using a specific product:
 - Claims 2 and 8: a petroleum derived feed; and
 - Claims 14 and 15: Fischer-Tropsch feed.Process Claims using products defined in terms of a process of manufacture are admissible only if the process Claims using the products as such fulfil the requirements of patentability, i.e. that they are new and inventive. A process is not rendered novel merely by the fact that a used product is produced by means of a new process.
3. The term "preferably" used in **Claim 6** is vague and unclear and leaves the reader in doubt as to the meaning of the technical feature to which it refers, thereby rendering the definition of the subject-matter of said Claim unclear.